

**RECEIVED
CENTRAL FAX CENTER
MAR 19 2009**

001/007

60,469-054
OT-4986**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application: Pedro S. Baranda
Serial No.: 10/010,937
Filed: 11/13/2001
Group Art Unit: 3656
Examiner: Charles, Marcus
For: ELEVATOR BELT ASSEMBLY WITH NOISE
AND VIBRATION REDUCING GROOVELESS
JACKET ARRANGEMENT

REPLY BRIEF

Box AF
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is in reply to the Examiner's Answer mailed on January 22, 2009.

Related Appeals

Appellant notes that the Examiner has identified Serial No. 09/921,803 as a potentially related case that is also on appeal. That application includes claims reciting a urethane coating that does not contain any wax. There are claims at issue in this appeal that recite a waxless polyurethane. In that sense, there may be a relationship between the two appeals in that one decision regarding a claim including a waxless urethane may affect or be affected by or have a bearing on the Board's decision in the other. There was no deceptive intent on the part of Appellant in the oversight for not mentioning that application number under the corresponding heading in Appellant's opening brief.

60.469-054
OT-4986**The rejection of claims 35 and 39 must be reversed.**

The Examiner still has not provided any reason for going contrary to the express language of 35 U.S.C. §103(c). The *Pitts, et al.* reference, which the Examiner relies upon for purposes of attempting to manufacture a *prima facie* case of obviousness against claims 35 and 39, cannot be used in a combination against Appellant's claims. As repeatedly pointed out by Appellant in this case, the claimed invention of the claims on appeal and the *Pitts, et al.* reference were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person. The *Pitts, et al.* reference and the pending application are commonly owned by Otis Elevator Company. The *Pitts, et al.* reference cannot be used against the claims of this application for purposes of attempting to manufacture a *prima facie* case of obviousness. The rejection of claims 35 and 39 must be reversed.

The Examiner's position on the Kilborn, et al. reference is incorrect.

Appellant has already explained how the Examiner is misapplying the teachings of the *Kilborn, et al.* reference. In the Examiner's Answer on page 9, the Examiner makes further misinterpretations of the reference. The Examiner suggests that the clamping member 13 is used to lower and raise the cable section in preparation for the introduction of a fabric layer around the cord section. There is no such teaching in the *Kilborn, et al.* reference. The raising of the clamping member is for purposes of placing it into a clamping position (or not). It has nothing to do with raising cables that are clamped. The teachings from column 5, line 51 – column 8, line 6 of the *Kilborn, et al.* reference make it clear that the cables remain on the table and that the carriage 14 is used to apply rubber from the top of those cables and then to apply a fabric layer on top of the rubber layer. There is nothing in the *Kilborn, et al.* reference that supports the Examiner's position on page 9 of the Examiner's Answer.

60,469-054
OT-4986

On that same page, the Examiner also says that Figure 7 shows cables between rubber pads 42 and 35. What is shown in Figure 7 is the portion of the cables within the clamps 13. The rubber pads are not part of a coating on the cables. Instead, they are sections of the cables that are trapped within the clamps and upon which the rubber and fabric coating cannot be applied because the carriage 14 does not interact with the portions of the cables inside of the clamps.

On page 10 the Examiner points to column 6, lines 4-19, as somehow suggesting some "other steps" beyond those already explained by Appellant. Nothing in that section of the *Kilborn, et al.* reference is contrary to Appellant's position that the cables remain laying on the table during the application of the rubber and fabric.

If the Examiner is suggesting that other steps are taken subsequent to what is taught in the *Kilborn, et al.* reference, then there is no more tension applied because the cables, rubber and fabric are removed and rolled on to a separate roll and the clamping mechanisms are no longer acting on the cables so that they are no longer being tensioned. Therefore, any hypothetical subsequent steps are inapposite to the analysis of Appellant's claims.

On page 10 of the Examiner's Answer, the Examiner overlooks the fact that the clamps 13 used in the *Kilborn, et al.* reference are applied across the entire set of cables so that the cables are not individually tensioned any longer once the clamps 13 are applied. Instead, the cables are all together tensioned using the single clamp at each end of the cables. The Examiner is correct that the jacket is applied while the cables are under tension but it is not applied while they are *individually* tensioned. The individual tensions used in the *Kilborn, et al.* reference are used prior to applying the clamping mechanism which is put in place before the jacket is applied.

60,469-054
OT-4986

On page 10 of the Examiner's Answer, the Examiner suggests that "It is inherent that any one of the cord that is not in alignment or not in proper tension will have to be adjust to be in proper alignment and tension with the other cords," for purposes of commenting on claims 3, 33 and 37. Appellant respectfully disagrees. There is nothing inherent about the *Kilborn, et al.* reference that any one of the cords can be adjusted according to the terms of those claims. Regarding claim 3, there is nothing whatsoever in the *Kilborn, et al.* reference that in any way suggests the inspection and adjustment recited in Appellant's claim 3.

Claims 33 and 37 require adjusting the tension on one of the cords while applying the jacket material to the cords. As is plainly stated in the *Kilborn, et al.* reference, all of the cables are clamped in the clamping mechanism 13 prior to the jacket being applied. There is no suggestion or teaching or reason to believe that it is in any way inherent in the *Kilborn, et al.* reference to release the clamping mechanism 13 from all of the cords for purposes of attempting to adjust one of the cords while applying the jacket. Instead, the *Kilborn, et al.* reference is clear that all of the cables are laid on the table and clamped in place and then the carriage 14 is moved across the table to apply the rubber to the cords. There is no room within the *Kilborn, et al.* reference to allow for making the individual cord tension adjustment as recited in claims 33 and 37 while the jacket is being applied. The Examiner is wrong and there is nothing inherent about cord adjustment in the *Kilborn, et al.* reference consistent with claims 3, 33 or 37.

Additionally, the *Kilborn, et al.* reference requires equal tension on all cables (col. 1, lines 36-38). It is not possible to adjust tension on one cord while applying the jacket without eliminating the required equal tension set before *Kilborn, et al.*'s rubber layer is applied.

With regard to claims 9 and 20, the Examiner suggests that "It is inherent that such processes included during the manufacturing of the outer layer rubber and fabric of *Kilborn, et al.*

60,469-054
OT-4986

...*Kilborn, et al.* is not concerned about making the jacket but applying the jacket on the tension member. Therefore, such method is only inherent in making the jacket but not the application of the jacket on the tension member." The Examiner's position in this regard is difficult to understand. Perhaps the Examiner is suggesting that there is some shaping of the rubber material before it is applied to the cables of *Kilborn, et al.* If so, that shaping (although it is nonexistent within the reference) has nothing to do with shaping a jacket after the jacket material has been applied to the cords. Moreover, if the Examiner is correct that *Kilborn, et al.* is not concerned about making the jacket but applying the jacket on the tension member, then there is further reason to believe that there is no inherency. If the only thing that *Kilborn, et al.* does is apply the jacket, then it doesn't care about shaping the jacket. Under the Examiner's own reasoning, there is nothing inherent in the reference about including shaping as required by Appellant's claims. There is no basis for the Examiner's inherency argument and, therefore, no basis for the rejection of claims 9 and 20.

When commenting on claim 16 on page 11 of the Examiner's Answer, the Examiner suggests that it "is possible to maintain the cord with different tension depending length of the cords." That is not possible because the express teachings of the *Kilborn, et al.* reference require equal tension on all of the cords. Appellant has already pointed out the repeated teaching of this within the *Kilborn, et al.* reference. The Examiner's position in this regard completely ignores the express teachings of the reference. There is no basis for the rejection of claim 16.

The Examiner's position regarding the *Harper* reference is incorrect.

Appellant has already pointed out how the *Harper* reference has to be correctly interpreted. The Examiner's position extrapolates from the reference and has no basis within it. There is nothing in the *Harper, et al.* reference that suggests or overtly teaches the use of a waxless

60,469-054
OT-4986

polyurethane. Appellant has already explained what is actually taught by the *Harper* reference. Moreover, the Examiner contends on pages 11 and 12 of the Examiner's Answer that wax is not inherently present in conventional polyurethanes. The Examiner says, "no such evidence exists." The co-pending application serial number 09/921,803 published as United States Patent Application Publication No. US 2003/0024770 states, "One difficulty associated with conventional urethane coatings is that the urethane material typically includes one or more waxes. The waxes typically are included as part of the urethane manufacturing process." That is evidence of record that urethanes typically include a wax. The Examiner has provided no evidence to the contrary. It is not Appellant's duty to prove what the conventional content of a urethane is. It is the Examiner's burden to establish a *prima facie* case of obviousness by demonstrating clearly that a reference teaches a urethane without wax. The *Harper* reference does not contain any such teaching.

The Examiner points to column 5, line 39 – column 6, line 33. Those lines include the statement that the polyurethane molding used in that reference is a composition commonly known in the art. It also states that it can contain "one or more surface active agents." One example surface active agent is an emulsifier. Waxes are used as emulsifiers in polyurethanes. Therefore, the *Harper* reference does not support the Examiner's position. Therefore, contrary to the Examiner's conclusion, "it must be concluded that wax is" a part of the composition of polyurethane.

The last paragraph on page 12 of the Examiner's Answer is not based on any information from the industry or the references. The Examiner contends that the use of wax on the surface of a belt would be disadvantageous because a belt used in an elevator system would be painted. There is no basis for that in any of the references of record.

60,469-054
OT-4986

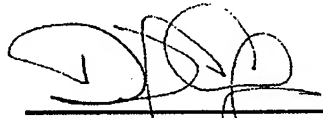
The Examiner has not addressed Appellant's arguments regarding many of Appellant's claims where the Examiner's position ignores or goes directly contrary to the express teachings of the references.

For all of the reasons above and those in Appellant's opening brief, all rejections must be reversed.

Respectfully submitted,

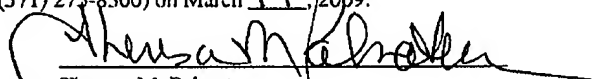
CARLSON, GASKEY & OLDS, P.C.

March 19, 2009
Date


David J. Gaskey
Registration No. 33,139
400 W. Maple, Suite 350
Birmingham, MI 48009
(248) 988-8360

CERTIFICATE OF FACSIMILE

I hereby certify that this Reply Brief, relative to Application Serial No. 10/010,937 is being facsimile transmitted to the Patent and Trademark Office (Fax No. (571) 273-8300) on March 19, 2009.


Theresa M. Palmateer

N:\Clients\OTIS ELEVATOR\IP00054\PATENT\Reply Brief 3-09.doc